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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 866,967	05/29/2001	Michael Gerard Gallagher	MP W-21927 A.AC 536	7387

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EXAMINER

HRUSKOI, PETER A

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 10/04/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/866,967

Applicant(s)

GALLAGHER ET AL.

Examiner

Peter A. Hruskoci

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 8-31 and 5-29-01, and 2-8-02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

Art Unit: 1724

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

I. Claims 1-12 and 16-18, drawn to a process, classified in class 210, subclass 728.

II. Claims 13-15, drawn to an apparatus, classified in class 210, subclass 205.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used in a materially different process such as a process for recovering hydrocarbons from emulsions.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and

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recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with David R. Crichton on 9-27-02 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12 and

1-18. Affirmation of this election must be made by applicant in replying to this Office

Art Unit: 1724

action. Claims 13-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: In the specification on pages 16 and 17 elements "[1]-[9]" are not labeled in Fig. 2.

Appropriate correction is required. . A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 2 "preferably" is vague and indefinite because it is unclear how this term further limits the claim.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Art Unit: 1724

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Pickering et al.. Pearson disclose (see col. 3 line 10 through col. 9 line 13) a process for combining polymeric particles with dispersed particulate solids substantially as claimed. The claims differ from Pearson by reciting that the particles have a specific intrinsic viscosity. Pickering et al. disclose (see col. 6 line 9 through col. 8 line 45) that it is known in the art to utilize polymer flocculants having recited intrinsic viscosity to aid in dewatering mineral suspensions pumped through a flow line. It would have been obvious to one skilled in the art to modify the process of Pearson by utilizing polymeric particles having the recited intrinsic viscosity in view of the teachings of Pickering et al., to aid in dewatering the aqueous fluid. The specific particle size of the polymers and dispersed solids, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific aqueous fluid treated and results desired, absent a sufficient showing of unexpected results.

10. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Pickering et al. as above, and further in view of Avotins et al.. The claims differ from the references as applied above by reciting that the polymer particles

comprising an inorganic salt. Avotins et

Art Unit: 1724

al., disclose (see col. 3 line 65 through col. 6 line 37) that it is known in the art to utilize a mixture of polymers and inorganic salts to aid in separating solids from Bayer process streams. It would have been obvious to one skilled in the art to modify the references applied above by utilizing the recited dispersion in view of the teachings of Avotins et al., to aid in separating solids from the aqueous fluid. The specific % by weight of inorganic salt in the dispersion, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific aqueous fluid treated and results desired, absent a sufficient showing of unexpected results.

11. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Pickering et al. as above, and further in view of Duan. It is noted that Pearson as applied above disclose the use of a vortex in a mixing chamber to aid in mixing the polymeric particles with the aqueous fluid. The claims differ from the references as applied above by reciting that a portion of the suspension flows into the mixing chamber where it is combined with a treatment chemical, and then returned to the flow line. Duan disclose (see col. 5 line 5 through col. 6 line 9) that it is known in the art to divide a feed stream into to separate streams, treat one of the streams with a metal ion precipitating agent, and recombine the streams for further mixing and separation. It would have been obvious to one skilled in the art to modify the references applied above

to divide the feed stream into two streams and returning the

Art Unit: 1724

mixed portion to the flow line in view of the teachings of Duan, to aid in precipitating metal ions in the suspension. The specific particle size of the treatment chemical, would have been an obvious matter of process optimization to one skilled in the art, depending on the specific aqueous fluid treated and results desired, absent a sufficient showing of unexpected results.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (703) 308-3839. The examiner can normally be reached on Monday through Friday from 6:30 AM to 4:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Simmons, can be reached on (703) 308-1972. The fax phone number for this Group is (703) 872-9310 (non-after finals) and 703-872-9311 after finals.

Application/Control Number: 09/866,967

Page 7

Art Unit: 1724

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
**Peter A. Hruskoci**  
**Primary Examiner**  
**Art Unit 1724**

P. Hruskoci  
September 30, 2002